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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91215788
Party	Plaintiff Vita Zahnfabrik H. Rauter GmbH & Co. KG
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of trademark application **Serial No. 85/821,103**

For the mark GRUPO VITALMEX and Design

Published in the Trademark *Official Gazette* on January 7, 2014, Page 157 (the term for opposition having been extended to May 7, 2014)

Vita Zahnfabrik H. Rauter GmbH & Co. KG

Opposer,

v.

Grupo Vitalmex, S.A. de C.V.

Applicant.

Opposition No. 91215788

AMENDED (PARTIAL) NOTICE OF
OPPOSITION

Vita Zahnfabrik H. Rauter GmbH & Co. KG, a limited partnership organized under the laws of Germany, whose address is Spitalgasse 3, Bad Sackingen, D-79713, Germany (hereinafter referred to as Opposer), believes that it will be damaged by registration of the mark for the goods "all purpose disinfectants" in International Class 5 and for the goods in International Class 10 as shown in Application Serial No. **85/821,103, by Grupo Vitalmex, S.A. de C.V.**, a company existing under the laws of Mexico, whose address is Blvd. Adolfo Ruiz Cortines 4284, Jardines del Pedregal, Coyoacan, Mexico D.F., 04500 Mexico (hereinafter referred to as Applicant) and hereby opposes its registration in International Class 10 and for the goods "all purpose disinfectants" in International Class 5.

As grounds for opposition, opposer alleges that:

1. Applicant is the owner by assignment (recorded with the U.S. Patent and Trademark Office on March 12, 2014 under reel/frame number 5235/0967) from Vitalmex Internacional S.A. de C.V. of the present intent-to-use application filed January 11, 2013.

2. Applicant seeks to register Intent-to-Use Application Serial No. 85/821,103 as a trademark for "pharmaceutical and sanitary products, dietetic substances for medical use, namely, antihypertensive drugs, metabolic syndrome drugs, pharmacogenomics, food for babies, medical plasters, all purpose disinfectants, preparations for destroying vermin, fungicides and herbicides" in International Class 5; "surgical and medical apparatus and instruments and highly specialized inputs for surgery, namely, artificial limbs, eyes and teeth, imaging equipment for tomography and radiography; suture material; orthopedic items, namely, ophthalmological prosthesis, heart valves, stents, grafts, artificial heart, hip prosthesis, tissues, mother cells" in International Class 10 and "hospital and medical care services" in International Class 44, claiming a bona fide intention to use the mark.

3. Since in or about the year 1928, Opposer, its predecessors and their related companies (hereinafter collectively referred to as Opposer) have been continuously engaged in the sale of dentistry products marketed to dentists and dental laboratories.

4. Since prior to Applicant's filing date, Opposer has continuously and extensively used in commerce in the United States the mark VITA and a number of VITA-containing marks (hereinafter collectively referred to as "VITA marks") in connection with dental products and services in the dental industry.

5. Opposer is the owner of Registration No. 0,259,601 for **VITA (stylized)**, issued August 6, 1929, for "artificial teeth" in International Class 10. Said registration is valid and subsisting.

6. Opposer is the owner of Registration No. 0,728,602 for **VITAFOL**, issued March 13, 1962, for "insulating material for use in making artificial teeth, teeth filling substances, especially ceramic and metallic teeth filling substances and teeth filling substances of synthetic resin as well as provisional teeth filling substances, metals for use in dental surgery and dentistry, varnishes and lacquers for use in dental surgery and dentistry, especially tooth lacquers, plastic films for use in dental surgery, artificial teeth, sets of artificial teeth and individual parts thereof (suction plates, dental clips and bridges)" in International Class 10. Said

registration is valid and subsisting and has become incontestable under the provisions of Section 15 of the Trademark Act.

7. Opposer is the owner of Registration No. 0,873,134 for **VITAPAN**, issued July 15, 1969, for "artificial teeth, dental-ceramic substances" in International Classes 5 and 10. Said registration is valid and subsisting and has become incontestable under the provisions of Section 15 of the Trademark Act.

8. Opposer is the owner of Registration No. 1,599,446 for **VITA IN-CERAM**, issued June 5, 1990, for "dental ceramics for the production of crowns and bridges" in International Class 10. Said registration is valid and subsisting and has become incontestable under the provisions of Section 15 of the Trademark Act.

9. Opposer is the owner of Registration No. 1,706,468 for **VITABLOCS**, issued August 11, 1992, for "teeth filling substances, namely ceramic teeth filling substances, ceramic plates for use in dentistry and dental surgery" in International Class 10. Said registration is valid and subsisting and has become incontestable under the provisions of Section 15 of the Trademark Act.

10. Opposer is the owner of Registration No. 2,403,822 for **VITA AKZENT**, issued November 14, 2000, for "dental colorants for individually adjusting the colors of dental prostheses made of dental ceramics" in International Class 5. Said registration is valid and subsisting and has become incontestable under the provisions of Section 15 of the Trademark Act.

11. Opposer is the owner of Registration No. 2,704,098 for **VITA PHYSIODENS**, issued April 8, 2003, for "artificial teeth" in International Class 10. Said registration is valid and subsisting and has become incontestable under the provisions of Section 15 of the Trademark Act.

12. Opposer is the owner of Registration No. 2,868,572 for **VITA SYSTEM 3D-MASTER**, issued August 3, 2004, for "dental restoration compounds, and materials for filling teeth" in International Class 5 and "artificial teeth, color scales for determining the colors of

dental restorative materials and artificial teeth to match natural tooth colors" in International Class 10. Said registration is valid and subsisting and has become incontestable under the provisions of Section 15 of the Trademark Act.

13. Opposer is the owner of Registration No. 2,903,036 for **VITAVM (stylized)**, issued November 16, 2004, for "dental restoration compounds, namely, dental ceramic or plastic materials for the preparation of artificial teeth or dental veneers" in International Class 5. Said registration is valid and subsisting and has become incontestable under the provisions of Section 15 of the Trademark Act.

14. Opposer is the owner of Registration No. 2,909,972 for **VITA EASYSHADE (stylized)**, issued December 14, 2004, for "dental spectral analysis apparatus and instruments for measuring optical properties of teeth and other dental objects and materials" in International Class 10. Said registration is valid and subsisting and has become incontestable under the provisions of Section 15 of the Trademark Act.

15. Opposer is the owner of Registration No. 3,433,716 for **VITA LINGOFORM**, issued May 27, 2008, for "artificial teeth" in International Class 10. Said registration is valid and subsisting.

16. Opposer is the owner of Registration No. 3,433,731 for **VITA VMK MASTER**, issued May 27, 2008, for "dental ceramic materials for the preparation of dental prostheses and veneers" in International Class 5. Said registration is valid and subsisting.

17. Opposer is the owner of Registration No. 3,552,401 for **VITA BLP**, issued December 30, 2008, for "training services in the field of preparation of dentures according to the laws of biological prosthetics; providing continuing dental education courses in the field of preparation of dentures according to the laws of biological prosthetics" in International Class 41. Said registration is valid and subsisting.

18. Opposer is the owner of Registration No. 3,606,354 for **VITA CAD-TEMP**, issued April 14, 2009, for "materials for partial and fully anatomic tooth bridges and tooth crowns" in International Class 5. Said registration is valid and subsisting.

19. Opposer is the owner of Registration No. 3,751,317 for **VITA VACUMAT**, issued February 23, 2010, for "baking devices for dental technicians and dentists, namely, dental furnaces" in International Class 11. Said registration is valid and subsisting.

20. Opposer is the owner of Registration No. 3,786,878 for **VITA MFT**, issued May 11, 2010, for "artificial teeth" in International Class 10. Said registration is valid and subsisting.

21. Opposer is the owner of Registration No. 3,789,528 for **VITA BLEACHEDGUIDE 3D-MASTER**, issued May 18, 2010, for "color scales for determining the colors of teeth" in International Class 10. Said registration is valid and subsisting.

22. Opposer is the owner of Registration No. 4,033,649 for **VITABLOCS REALLIFE (stylized)**, issued October 4, 2011, for "dental ceramic compositions in the form of blocks for preparing ceramic restorations" in International Class 5. Said registration is valid and subsisting.

23. Opposer is the owner of Registration No. 4,058,723 for **VITA PM**, issued November 22, 2011, for "dental restorative materials, namely, shaded porcelain materials" in International Class 5. Said registration is valid and subsisting.

24. Opposer is the owner of Registration No. 4,121,573 for **VITAPAN PLUS**, issued April 3, 2012 for "artificial teeth" in International Class 10. Said registration is valid and subsisting.

25. Opposer is the owner of Registration No. 4,204,673 for **VITA ShadeAssist**, issued September 11, 2012 for "communication software for dental purposes, namely, for detailed tooth color prescription, case planning and patient data storage" in International Class 9. Said registration is valid and subsisting.

26. Opposer is the owner of Registration No. 4,204,680 for **VITA ENAMIC**, issued September 11, 2012 for "dental ceramics with plastic fractions for preparing dental prostheses" in International Class 5. Said registration is valid and subsisting.

27. Opposer is the owner of pending Application Serial No.85/929,191 for **VITA Adiva** for "dental preparations, compounds, substances, and materials, namely, dental restoration

compounds, dental cement, dental resins, dental adhesive resins, dental adhesive cement, pastes for dental restoration, self-etching primer for dental restoration, etching materials with acidic agents for dental restoration, etching gel for dental restoration; dental composite materials, namely, mounting composites used in dentistry and silane-coupling agents for dental surface treatment of ceramics, hybrid ceramics and composite resins" in International Class 5 and "mounting systems primarily comprised of dental composite materials for mounting of dental prosthetics, anterior and posterior crowns, suprastructures on implants, veneers, inlays and onlays, used in dentistry" in International Class 10.

28. Opposer is the owner of pending Application Serial No. 85/927,735 for **VITA Fortec** for "soldering chemical agents for use in dental technology; chemicals for use in dentistry and dental technology, namely, chemicals for cleaning, treating and microbially decontaminating equipment and instruments, namely, chemical degreasing and cleaning solvents; unprocessed artificial resins for dentistry and dental technology; bonding agents for making dental prostheses" in International Class 1; "goods relating to dentistry, namely, dental ceramic for making dentures; glass powder for making dentures; disinfectants for use in dentistry for use on dental prosthetics and dental instruments; disinfectant for cleaning dental instruments; teeth filling materials, in particular, material for stopping teeth of ceramic and material for stopping teeth of artificial resins and temporary material for stopping teeth; dental cement; impression material for use in dentistry and dental technology, in particular impression plaster, dental impression wax, plastic dental impression materials; varnishes and lacquers for use in dentistry and dental technology, in particular dental lacquer; wax for use in dentistry and dental technology; modeling compounds and modeling goods for dental purposes, namely, dental modeling wax, dental modeling impression material, dental ceramic for modeling of dental prosthetics, anterior and posterior crowns, suprastructures on implants, bridges, veneers, inlays and onlays, ingots; cement and plaster for use in dentistry and dental technology; dental prosthetic materials, namely, metal-ceramic, glass-ceramic, hybrid ceramic, composite resins and all-ceramic fastening materials for dentures; ceramic materials for making dentures; materials for

making dental restorations, namely, anterior and posterior crowns, suprastructures on implants, bridges, veneers, inlays and onlays, ingots of dental ceramic, dental glass-ceramic, dental hybrid ceramics or dental composite resins; modeling materials for dental purposes, namely, dental impression materials for dental purposes; dental ceramics and dental glass-ceramics for the cad/cam production of tooth care materials, namely, dental prosthetics, anterior and posterior crowns, suprastructures on implants, bridges, inlays and onlays crowns, ingots and veneers" in International Class 5; "goods relating to dentistry, namely, artificial teeth of dental ceramic, dental prostheses and individual structural parts therefor, dental bridges, artificial teeth of plastic; dental apparatus and instruments, namely, color rings, crown pushers, mixing trays, glass and porcelain instrument dishes, instrument trays, spatulas, bottles, glasses and tablet tubes" in International Class 10 and "insulating materials for making dental prostheses" in International Class 17.

29. Opposer is the owner of pending Application Serial No. 85/927,750 for **VITA Suprinity** for "soldering chemical agents for use in dental technology; chemicals for use in dentistry and dental technology, namely, chemicals for cleaning, treating and microbially decontaminating equipment and instruments, namely, chemical degreasing and cleaning solvents; unprocessed artificial resins for dentistry, dental technology and dental surface treatment of ceramic, glass ceramic, hybrid ceramics or composite resins; bonding agents for making dental prostheses and repairing of fractured crowns and bridges made of ceramics, hybrid ceramics or composite resins" in International Class 1; "goods relating to dentistry, namely, dental ceramic for making dentures, dental prosthetics, anterior and posterior crowns, suprastructures on implants, bridges, veneers, inlays and onlays, ingots; ceramic glass powder for making dentures or partial dental prosthetics, anterior and posterior crowns, suprastructures on implants, bridges, veneers, inlays and onlays, ingots; disinfectants for use in dentistry for use on dental prosthetics and dental instruments; disinfectant for cleaning dental instruments; teeth filling materials, in particular, material for stopping teeth of ceramic and material for stopping teeth of artificial resins and temporary material for stopping teeth; dental cement; impression

material for use in dentistry and dental technology, in particular impression plaster; dental impression wax; dental impression materials; varnishes and lacquers for use in dentistry and dental technology, in particular dental lacquer; wax for use in dentistry and dental technology; modeling compounds and modeling goods for dental purposes, namely, dental modeling wax, dental modeling impression material, dental ceramic for modeling of dental prosthetics, anterior and posterior crowns, suprastructures on implants, bridges, veneers, inlays and onlays, ingots; cement and plaster for use in dentistry and dental technology; dental prosthetic materials, namely, metal-ceramic, glass-ceramic, hybrid ceramics, composite resins and all-ceramic fastening materials for dentures; ceramic materials for making dentures; materials for making dental restorations, namely, anterior and posterior crowns, suprastructures on implants, bridges, veneers, inlays and onlays, ingots of dental ceramic, dental glass-ceramic, dental hybrid ceramics or dental composite resins; modeling materials for dental purposes, namely, dental impression materials for dental purposes; dental ceramics and dental glass-ceramics for the cad/cam production of tooth care materials, namely, dental prosthetics, anterior and posterior crowns, suprastructures on implants, bridges, inlays and onlays crowns, ingots and veneers" in International Class 5; "goods relating to dentistry, namely, artificial teeth of dental ceramic and dental glass-ceramic, dental prostheses and individual structural parts therefor, dental bridges, artificial teeth of plastic, hybrid ceramics or composite resins; dental apparatus and instruments, namely, color rings, crown pushers, mixing trays, glass and porcelain instrument dishes, instrument trays, spatulas, bottles, glasses and tablet tubes" in International Class 10 and "insulating materials for making dental prostheses, crowns, suprastructures on implants, bridges, veneers, inlays and onlays, ingots" in International Class 17.

30. Opposer is the owner of pending Application Serial No. 86/092,388 for **VITA VIONIC** for "materials for making dental prostheses, and materials for making temporary crowns and bridges, namely, rubber, plastics, metal alloys, modeling wax used in dentistry and abrasives used in dentistry; insulating materials and bonding agents for making prostheses; plastics used in dentistry; impression and modeling materials for use in dentistry" in International

Class 5 and "goods relating to dentistry, namely, artificial teeth of dental ceramic, dental prostheses and individual parts therefor, dental bridges, fastening materials for dental prostheses, artificial teeth of plastic; dental technical apparatus and instruments, in particular color rings; crown pushers for dental purposes" in International Class 10.

31. Opposer, through the use of its "VITA marks," and by virtue of the goods and services sold there under, has built up a valuable goodwill and reputation in connection with said marks, which would be jeopardized by the Applicant's use and registration of the mark GRUPO VITALMEX and Design for "all purpose disinfectants" in International Class 5 and for "surgical and medical apparatus and instruments and highly specialized inputs for surgery, namely, artificial limbs, eyes and teeth, imaging equipment for tomography and radiography; suture material; orthopedic items, namely, ophthalmological prosthesis, heart valves, stents, grafts, artificial heart, hip prosthesis, tissues, mother cells" in International Class 10.

32. The goods "all purpose disinfectants" in International Class 5 and the goods in International Class 10 for which Applicant seeks to register its mark GRUPO VITALMEX and Design are closely related to the goods sold by Opposer under its "VITA marks."

33. The Applicant's mark GRUPO VITALMEX and Design so resembles Opposer's "VITA marks," previously used in commerce and/or registered in the United States Patent and Trademark Office and not abandoned, as to be likely, when applied to the goods "all purpose disinfectants" in International Class 5 and to the goods in International Class 10 of Applicant, to cause confusion or to cause mistake or to deceive.

34. Opposer would be damaged by the issuance to Applicant of a registration of the mark GRUPO VITALMEX and Design for the goods "all purpose disinfectants" in International Class 5 and for the goods in International Class 10 as set forth in Application Serial No. 85/821,103.

WHEREFORE, Opposer prays that application Serial No. **85/821,103** with respect to the goods "all purpose disinfectants" in International Class 5 and to the goods in International Class 10 be rejected, and that the mark therein sought for the goods "all purpose disinfectants" in International Class 5 and the goods herein specified in International Class 10 be refused registration.

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP


Date April 11, 2014

By David A. Dillard
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CERTIFICATE OF SERVICE

I certify that on April 10, 2014, the foregoing AMENDED (PARTIAL) **NOTICE OF OPPOSITION** is being served by mailing a copy thereof by first-class mail addressed to:

Mariana P. Noli, Esq.
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